

REMARKS

Claims 1-3 are pending in this application. Claim 3 stands rejected and claims 1 and 2 are objected to for various informalities. Applicants wish to thank the Examiner for the indication of allowable subject matter in claims 1-2. By this Amendment, claims 1-3 have been amended. The amendments made to the claims do not alter the scope of these claims, nor have these amendments been made to define over the prior art. Rather, the amendments to the claims have been made for cosmetic reasons to improve the form thereof. In light of the amendments and remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Claims 1 and 2 were rejected for various informalities. Applicants have amended claims 1 and 2 in light of the Examiner's rejections. Therefore, allowance of claims 1 and 2 is requested.

Claim 3 stands rejected under 35 U.S.C. § 112, second paragraph, for being unclear. Applicants have amended claim 3 in line with the Examiner's comments. As such, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,157,622 ("Tanaka") in view of U.S. Patent No. 6,611,526 ("Chinnaswamy") and further in view of U.S. Patent No. 6,697,359 ("George"). Applicants respectfully request reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

The Office Action utilizes three references to disclose each of the three limitations in Applicants' claim. Applicants respectfully assert that the explicitly recited limitations in Applicants' claim is not disclosed in the cited references and there is no motivation provided to combine these three references.

The Office Action asserts that Tanaka discloses at least one calculation-type address having bits "1" corresponding to destinations to which a multicast packet is to be transferred. However, Tanaka merely discloses that a sending information generation section calculates the multicast address according to terminal identifiers of each destination terminal stored in the terminal information memory section. There is no disclosure of at least one calculation type address having bits "1" corresponding to destinations. As such, this limitation is not disclosed by Tanaka.

The Office Action then includes Chinnaswamy to disclose Applicants' second limitation of at least one directional route mask having bits "1" corresponding to those direction routes in which a multicast packet is to be transferred. However, Chinnaswamy merely discloses that the destination mask field is the field holding of the mask of slots in the current chassis to which the packet is destined, which may or may not be the final destination in the system. Chinnaswamy does not disclose a directional route mask but a destination mask. Tanaka and Chinnaswamy fail to disclose the first two limitations explicitly recited in Applicants' claim. The references fail to disclose Applicants' recited limitations. Thus, a *prima facie* case of obviousness has not been made.

Further, to support a *prima facie* case of obviousness requires, among other things, that a motivation be identified, in the prior art itself, that would have caused one of skill in the art to make any proposed modification of the primary reference or to combine references. Further, if more than two references are combined, the motivation must be to combine *all three references*. This is because there must be a motivation to make the *two-fold modification* of the primary reference. Here, the Examiner has attempted to combine three references, one for each limitation in Applicants' claim without any motivation.

In the Office Action, in reference to claim 3, the Examiner took the position that it would have been obvious to combine Tanaka with Chinnaswamy to provide a directional route mask, and then includes George for the disclosure of a terminal mask. However, the Examiner took the position that it would have been

obvious to include the above features of Tanaka with Chinnaswamy and George because it would “route the multicast packets efficiency.”

The fact that an advantageous feature of the Applicants’ invention increases efficiency is *not* evidence that it would have been obvious to have added the feature that promotes such efficiency. On the contrary, the fact that the prior art has no teaching or suggestion of a feature, combined with the fact that the feature is particularly advantageous, is evidence of *non*-obviousness, not its opposite. If the rule followed in the Office Action were followed, then the most advantageous inventions would be the most obvious. Of course this is not true. Thus, the motivation for the initial modification of Tanaka to include the features of Chinnaswamy is deficient, and for at least this reason, no prima facie case of obviousness has been established.

Moreover, the Office Action is equally deficient in the motivation provided for making the *further* modification to allegedly meet the feature of the terminal mask. It is conceded in the Action that even when combined, Tanaka and Chinnaswamy do not teach this feature. George is cited as remedying this deficiency. The motivation provided is, as discussed above, because it would “route the multicast packets efficiency.”

However, it is not sufficient in a three-way combination to provide motivation in a step-wise or serial manner. There must have been motivation in the prior art, and that motivation must be identified by the Examiner, to combine *all of the references* to meet the claim *as a whole*. The motivation provided in the Office

Action for the additional modification to include the features of George is stated in terms of why it would have been obvious to modify *the combination of Tanaka and Chinnaswamy*, treating that combination as a given, and thus fails to provide the required motivation.

By treating the initial combination as a given, the motivation provided for the further modification is not sufficient since it does not even allege to constitute motivation to make *the entire combination*. The motivation provided is completely deficient at least because it is a motivation to modify a hypothetical construct, namely the combination of Tanaka and Chinnaswamy, that is, a motivation to modify something that does not exist. For this additional reason, no prima facie case of obviousness has been set forth.

The only motivation for adding a directional route mask to Tanaka is the motivation to meet this feature of the claim, which is, of course, improper, and in fact amounts to a hindsight reconstruction of the claim. The additional motivation to make the modification of the hypothetical combination of Tanaka and Chinnaswamy also is deficient for the reasons given above. In view of the failure of the Office Action to provide *any* legally acceptable motivation for the recited first combination, still less the three part combination, no prima facie case of obviousness has been set forth with regard to claim 3. Accordingly, claim 3 is patentable over the cited art.

Applicants have responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated:

Respectfully submitted,

By 

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